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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,836	04/28/2000	James Grossman	204,307	4613
23413	7590	10/01/2003	EXAMINER	
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002				LE, KHANH H
ART UNIT		PAPER NUMBER		
3622		7		

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/560,836	GROSSMAN, JAMES	
	<b>Examiner</b>	<b>Art Unit</b>	
	Khanh H. Le	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 7/24/2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14, 20-22 and 24-37 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) 1-10, 11-14, 20-22, 24-29, 30-37 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

### **Non-Final Action/ Restriction**

1. This Office Action is in response to the Response, dated 7/24/2003. The abstract has been added. Claims 1,3-7, 11-12, 14, 20, 30, 37 have been amended. Claims 15-19,23, 38-39 are cancelled. Thus claims 1-14, 20-22, 24-29, 30-37 are pending. Claims 1, 11, 20, 30 are independent.

### **REQUIREMENT FOR ELECTION/RESTRICTION**

2. Applicant is advised herewith that the reply to this requirement to be complete must include an election of one species is required because claim to a generic invention (genus) and claims to more than one patentably distinct species are claimed in the same application and because the search and examination of an unreasonable amount of species associated with 37 claims in the instant application cannot be made without serious burden. (See 37 CFR 1.141; 37 CFR 1.142; and 37 CFR 1.146). **Applicant has one month to respond (See MPEP 809.02(a)).**

### **MPEP 803: RESTRICTION — When Proper**

3. The following is a quotation of an informational statement about restriction requirements:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(I)) or distinct (MPEP § 806.05 - § 806.05(I)). If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

### **37 CFR 1.142 Requirement for restriction:**

4. If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). **Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.**

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:

**Group I.** **Claims 1-10**, drawn to distributing paper sheets with preprinted ads thereon then registering on the Web to confirm use of such papers and receive credits therefor \*classified in class 705, subclass 14.

**Group II.** **Claims 11-14**, drawn to downloading the ads as well as the content onto printable papers, classified at least in class 283, subclass 56.

**Group III.** **Claims ( claims 20-22, 24-29),**, drawn to downloading prescribed content from the web from authorization indicia obtained from opening sheet packages, classified in class 283, subclass 72.

**Group IV:** **Claims 30-37** drawn to a method for connecting printing hardware systems, and programming for downloading the ads as well as the content onto printable papers, at least classifiable in class 709, subclass 200.

**Further as to Group IV, an election of species out of the following 4 species groups is required :**

**Group IV a) . Claims 30-31, 32, 34 ,** drawn to a method for connecting printing hardware systems, and programming for downloading the ads as well as the content onto printable papers, classified in class 709, subclass 200.

**Group IV b). Claim 33,** dependent on claim 30, drawn to different ads printed on sequential sheets , classified in class 710, subclass 217.

**Group IV c) Claim 35-36 ,** dependent on claim 30, drawn to IC in the printer housing, classified in class 709, subclass 310.

**Group IV d) Claims 37,** dependent on claim 30, drawn to IC device in an external modem linking printer and computer, classified in class 709, subclass 321.

6. This application contains claims 30-37 which are directed to the following patentably distinct species of the claimed invention:

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. **Currently, Claim 30 is generic to claims 31-37.**

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

**Thus as to Groups IV a) –d)**

The inventions of the genus and the species are distinct, each from the other because:

**(1) the genus (invention IV a) ) as claimed does not require the particulars of the species as claimed for patentability, and (2) that the species (Inventions IV b), c) or d) ) has utility by itself or in other combinations (MPEP § 806.05(c)).**

**Inventions IV a) and IV b )**

In the instant case, the inventions of Group IV a) as claimed does not require the particulars of the species IV as claimed because different ads printed on sequential sheets are the particulars of the species which is not required in the invention of Group IV a) for patentability.

Further, the Group IV b) species features, such as cited above, have separate utility by themselves or in other combinations because all these features are extra features that are not required in the claims of Group IV a) .

**Inventions IV a) and IV c )**

In the instant case, the inventions of Group IV a) as claimed does not require the particulars of the species IV c) as claimed because the IC in the printer housing are the particulars of the species which is not required in the invention of Group IV a) for patentability.

Further, the Group III species features, such as cited above, have separate utility by themselves or in other combinations because all these features are extra features that are not required in the claims of Group IV a) .

**Inventions IV a) and IV d )**

In the instant case, the inventions of Group IV a) as claimed does not require the particulars of the species IV as claimed because to the IC device in an external modem linking

printer and computer are the particulars of the species which is not required in the invention of Group IV a) for patentability.

Further, the Group IV d) species features, such as cited above, have separate utility by themselves or in other combinations because all these features are extra features that are not required in the claims of Group IV a).

7. The following inventions are distinct, each from the other because of the following reasons:

**A) Group I vs. Groups II, III, IV a)-d)** :

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, Group I involves distributing paper sheets with preprinted ads thereon then only registering on the Web to confirm use of such papers, while Group II involves downloading the ads as well as the content onto printable papers therefore they are not disclosed as capable of use together (since the ads are already pre-printed in Group I they don't need to be printed as claimed in Group II) and they have different modes of operation (same reasons).

Inventions I and III are related as **combination and subcombination**. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination as claimed (Group III involves downloading prescribed content from the web from authorization indicia obtained from opening sheet packages) does not require the particulars of the subcombination, Group I, as claimed for patentability because Group III does not require the particulars of Group I, which involves distributing paper sheets with preprinted ads thereon then only registering on the Web to confirm use of such ad-bearing papers and receive credits for it . Further the subcombination, Group I, has separate utility by itself such as distributing paper sheets with preprinted ads thereon then only registering on the Web to confirm use of such ad-bearing papers and receive credits for it , which is not claimed in Group III.

Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case as to Group I vs. Group IV, Group I involves a method for distributing paper sheets with preprinted ads thereon then only registering on the Web to confirm use of such papers, while Group II involves a method for connecting printing hardware systems, programming for downloading the ads as well as the content onto printable papers therefore they are not disclosed as capable of use together (since the ads are already pre-printed in Group I they don't need to be printed as claimed in Group I (since the ads are already pre-printed in Group I they don't need to be printed

as claimed in Group IV) and they have different modes of operation, different functions, or different effects (for the same reasons).

It follows from the election of species of Group IV above that Invention I is also distinct from Groups IV a), IV b), IV c) and IV d).

**B) Group II vs. Groups III, IV a) –d):**

Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).  
In the instant case, the combination as claimed (Group III involves downloading prescribed content from the web from authorization indicia obtained from opening sheet packages) does not require the particulars of the subcombination, Group II, as claimed for patentability because Group III does not require the particulars of Group II, which involves downloading the ads as well as the content onto printable papers and receiving credits for using such ads-bearing sheets . Further the subcombination, Group II, has separate utility by itself such as receiving credits for printing ads-bearing sheets , which is not claimed in Group III.

Inventions II and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).  
In the instant case, the combination as claimed (Group IV involves a method for connecting printing hardware systems, and programming for downloading the ads as well as the content onto printable papers) does not require the particulars of the subcombination, Group II, as claimed for patentability because Group IV does not require the particulars of Group II, which involves downloading the ads as well as the content onto printable papers and receiving credits for using such ads-bearing sheets.  
Further the subcombination, Group II, has separate utility by itself such as receiving credits for printing ads-bearing sheets , which is not claimed in Group IV.

It follows from the election of species of Group IV above that Invention I is also distinct from Groups IV a), IV b), IV c) and IV d).

**C) Group III vs. Groups IV a) –d):**

Group III involves downloading prescribed content from the web from authorization indicia obtained from opening sheet packages

Group IV involves a method for connecting printing hardware systems, and programming for downloading the ads as well as the content onto printable papers

Inventions II and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).  
In the instant case, the combination as claimed (Group IV involves a method for connecting printing hardware systems, and programming for downloading the ads as well as the content onto printable papers) does not require the particulars of the subcombination, Group III, as claimed for patentability because Group IV does not require the particulars of Group III, which involves downloading prescribed content from the web from authorization indicia obtained from opening sheet packages.  
Further the subcombination, Group III, has separate utility by itself such as downloading prescribed content from the web from authorization indicia obtained from opening sheet packages, which is not claimed in Group IV.

It follows from the election of species of Group IV above that Invention I is also distinct from Groups IV a), IV b), IV c) and IV d).

8. Because these inventions are distinct for the reasons given above and the search required for each Group, as listed above is not required for each other Group as listed above, restriction for examination purposes as indicated is proper.

### Conclusion

9. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can best be reached on Tuesday-Wednesday 9:00-6:00. The examiner can also be reached at the e-mail address: [khanh.le2@uspto.gov](mailto:khanh.le2@uspto.gov). ( However, Applicants are cautioned that confidentiality of email communications cannot be assured.)

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

September 25, 2003

*KHL*

KHL

*Stephen Gravini*  
STEPHEN GRAVINI  
PRIMARY EXAMINER